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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/934,479

08/23/2001

Yoko Fujiwara

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8426

7590

02/25/2009

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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2628

MAIL DATE

DELIVERY MODE

02/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/934,479	<b>Applicant(s)</b> FUJIWARA ET AL.	
	<b>Examiner</b> Jeffery A. Brier	<b>Art Unit</b> 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-34 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-34 and 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on 12/08/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 12/08/2008 have been fully considered but they are not persuasive.

### ***Information Disclosure Statement***

3. The US patent no. 6,466,954 was lined through on the 9/19/2008 IDS since this patent is already of record, see the 07/15/2003 PTO-892.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-9, 11-34, and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 5, 9, 11, 13, 17, 27, 32, and 33:

Independent claims 1, 3, 5, 17, 27, 32, and 33 claim "detecting a user selection of a plurality of document blocks that is marked by the user by scanning a document on which the user has marked the plurality of document blocks" and independent claims 9, 11, and 13 claim "detect a user selection of a plurality of document blocks that is

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marked by the user by scanning a document on which the user has marked the plurality of document blocks” while the specification at page 9 lines 3-11 describes step S101 and at page 9 lines 12-24 describes step S102 while dependent claim 8 claims “wherein the detecting means includes a reader for optically reading the document” and dependent claim 16 claims “wherein the detecting step includes a step of reading the document”. Thus, the means or steps of the specification covered by the above quoted claim limitations is unclear. Determining the metes and bounds of these claim limitations is needed in order for one of ordinary skill in the art to determine the metes and bounds of the claimed invention and in order to compare the prior art with the claims. Kurosawa teaches at column 1 lines 29-36 a step similar to applicants step S102 and newly cited Bloomberg teaches a step similar to applicants step S101. Determining the metes and bounds of this claim limitation is also needed in order to determine if a machine or mathematical algorithm is claimed by each of the claims. In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008). Step S101 appears to be tied to a particular machine while step S102 appears to be a mathematical algorithm.

The dependent claims do not correct this issue.

Claims 12:

At line 2 “wherein image processing further comprises” which lacks antecedent basis because “image processing” was not claimed in parent claim 11.

Claim 16:

At line 2 “the detecting step lacks antecedent basis in the claim.

Claims 18, 21, and 24:

These claims each claim "wherein the plurality of document blocks is a marked portion of the document" and the parent claims already claim "the user has marked the plurality of document blocks". Claims 18, 21, and 24 are unclear because they each claim "a marked portion" while parent claims 1, 9, and 17 implied a mark for each marked document block.

Claims 29-31:

The claimed "total area of the extracted document block" lacks antecedent basis in the claim since more than one block is extracted since "the user has marked the plurality of document blocks".

Claim 33:

At line 5 applicant claims "a perimeter" marks the plurality of document blocks, however, if "a perimeter" is one perimeter then applicant has failed to clearly claim how one perimeter will mark a plurality of document blocks. Dependent claims 34 and 47 do not correct this issue.

### ***Conclusion***

6. An analysis of the claimed invention with regard to the prior art will be held in abeyance until the claimed invention has been clarified since the metes and bounds of the claims are not definite. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding

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the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions). US Patent and Trademark Office Appeal No. 2008-0580, Ex Parte Bobroski, decided March 31, 2008.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bloomberg et al., US Patent No. 5,201,011, teaches a scanning machine for scanning a document marked by a user with an ordinary writing utensil for use in systems which identify regions for image processing, column 1 lines 25 to column 2 line 41.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7661. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Art Unit 2628